

REMARKS

Introduction

This Amendment is presented as a substitute for the Amendment previously submitted by applicants on June 26, 2003. After submitting the Amendment on June 26, 2003, applicants received a "Notice of Non-Compliant Amendment" dated July 16, 2003. Accordingly, in response to that "Notice of Non-Compliant Amendment," applicants submit the present Amendment. The present Amendment is substantially similar to the previously submitted (and non-entered) Amendment of June 26, 2003, but with a revised "Listing of Claims" section (beginning on page 2) as requested in a "Notice of Non-Compliant Amendment." The present Amendment is being filed within the period for response to the "Notice of Non-Compliant Amendment," the period for such response extending to and including August 18, 2003 (August 16, 2003 falling on a weekend).

Claims 1-3, 6, 8 and 9 were in the application. By this Amendment, applicants have cancelled claim 6 without prejudice. Applicants also submit, concurrently herewith, Declarations of Nick Guise (Exhibit 1) and Neil Campbell (Exhibit 2), as well as copies of the previously submitted Declarations of Betty Fatzie (Exhibit 3) and Dietrich Crase (Exhibit 4). Accordingly, claims 1-3, 8 and 9 are presently in the application. Claims 1, 3, 8 and 9 are independent. Applicants also filed, with the Amendment previously filed on June 26, 2003, a Request for Continued Examination (RCE) as well as a Petition for Extension of Time and fee authorization.

In the Office Action, claims 1 and 2 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,349,923 to Sheaffer et al. (Sheaffer) in view of applicants' admitted prior art (AAPA). Also, in the Office Action, claims 3, 8 and 9 were rejected under 35 U.S.C. §103 as being unpatentable over a hypothetical combination of Sheaffer and U.S. Patent No. 5,894,816 to Coiro, Sr. et al. (Coiro).

As set forth in detail below, and as supported by the Declarations filed concurrently herewith, applicants respectfully traverse these rejections.

With respect to the rejections of claims 1 and 2, in the Office Action, it is conceded that Sheaffer does not disclose the limitation of "the floor of the cage bottom having a length l and a width w wherein $80 \text{ square inches} \leq l \times w \leq 110 \text{ square inches}$ " as is recited by claim 1 of the present application, nor the limitation of "the floor of the cage bottom having a length l and a width w wherein $l \times w$ is substantially 80 square inches" as recited by claim 2 of the present application.

In an attempt to overcome these deficiencies, the Office Action relies on applicants' specification, and more precisely, applicants' discussion of prior art ventilated cage and rack systems. Specifically, the Office Action points to the specification of the present application, where applicants discuss certain non-binding minimum dimensions of cages for particular rodents (e.g., mice and rats).

Based upon applicants' discussion of prior art ventilated cage and rack systems, the Office Action takes the position that it would be obvious to modify Sheaffer to arrive at the invention claimed by claims 1 and 2 of the present invention.

With respect to claims 3 and 8, it is conceded in the Office Action that Sheaffer does not disclose a cage having a length of substantially 18 inches. To attempt to cure this deficiency, the Office Action relies upon Coiro. With respect to claim 9, the Office Action, as in the rejection to claim 3, employs a hypothetical combination of Sheaffer and Coiro, but concedes that this hypothetical combination does not disclose a portion of the cage extending beyond the rack. The Office Action, however, characterizes this feature as being obvious, without setting forth any support for this characterization.

Applicants respectfully submit, however, that the invention claimed by claims 1 and 2 of the present application is not obvious in view of Sheaffer and AAPA, and that the invention claimed by claims 3, 8 and 9 is not obvious in view of a hypothetical combination of Sheaffer and Coiro. To the contrary, the claimed invention was the result of applicants' inventive discovery of a problem and the source thereof. For this reason, as set forth in detail below, and as supported by the Declarations filed concurrently herewith, applicants respectfully traverse the rejection of claims 1, 2, 3, 8 and 9 under 35 U.S.C. § 103.

Discovering Source Of A Problem Overcomes Obviousness Rejections

Applicants respectfully submit that they have inventively discovered a problem, and in addition, have discovered the source of that problem and the solution thereto. Thus, applicants discovered that a problem existed, and the discovery of that problem was an inventive aspect of the invention claimed in the Application. Specifically, prior to the invention claimed in the Application, no one in the industry recognized the fact that each of the then current rack and cage systems were only designed to efficiently house a single species of animal within ILAR

guidelines was a problem. Applicants recognized that there was a problem and that the solution to the problem was to provide a cage and rack system that was capable of efficiently housing more than one species of animal, while simultaneously meeting the ILAR requirements for housing each of those animal species. Thus, in the prior art, there was no recognition of the problem of the inefficient use of lab space being caused by the size of animal cages, let alone any solution to that problem.

To overcome an obviousness rejection, an applicant may submit objective evidence that applicant discovered the source of a problem. “[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the ‘subject matter as a whole’ which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103.” *In re Spinnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969); MPEP § 2141.02.

Applicants who allege they discovered the source of a problem must provide evidence substantiating the allegation, either by way of affidavits or declarations, or by way of a clear and persuasive assertion in the specification. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979); MPEP § 2141.02. Accordingly, applicants respectfully submit herewith the Declarations of Nick Guise and Neil Campbell to support applicants’ position that the present invention is not obvious in view of the Office Action’s proposed hypothetical combination of Sheaffer and AAPA, nor the Examiner’s proposed hypothetical combination of Sheaffer and Coiro, because applicants’ claimed invention is the result of the inventive discovering of a problem, and the source thereof.

In *In re Sponnoble*, the claim was directed to a plural compartment mixing vial wherein a center seal plug was placed between two compartments for temporarily isolating a liquid-containing compartment from a solids-containing compartment. The claim differed from the prior art in the selection of butyl rubber with a silicone coating as the plug material instead of natural rubber. The prior art recognized that leakage from the liquid to the solids compartment was a problem, and considered the problem to be a result of moisture passing around the center plug because of microscopic fissures inherently present in molded or blown glass. The court found the inventor discovered the cause of moisture transmission was through the center plug, and there was no teaching in the prior art which would suggest the necessity of selecting applicant's plug material which was more impervious to liquids than the natural rubber plug of the prior art. *In re Sponnoble*, 405 F.2d at 585; MPEP § 2141.02.

Similarly, as further described below, and as supported by the Declarations submitted concurrently herewith, in the present application, applicants inventively discovered a problem, and the source of that problem. Prior to the conception of the instant claimed invention, each cage and rack system sold in the market was designed and dimensioned specifically to meet Institute for Laboratory Animal Research (ILAR) guidelines for a specific animal species. Because each cage and rack system was built around the size of the cage, each of the different rodent cages and systems had different cage and rack footprints for different rodent types. Thus, a mice-only cage and system takes up a different amount of laboratory and inventory space than a rat-only cage and rack system. Consequently, efficient use of valuable laboratory and inventory space was ignored because the type of rodent being evaluated (and thus the size of the

cage and system required) would be subject to change, based on the type of rodent that would be used by a particular study.

Prior to the invention claimed in the Application, there was no recognition that the use of lab space was inefficient or in any way related to the size of the animal cages. No thought was given to the fact that the cause of these inventory and size problems was a result of the size and the complexity of each of the different rack and cage systems.

First, applicants recognized that there was a problem. Next, applicants discovered that the cause of the problem was not that a particular cage and rack system for a specific animal species should be made to have a smaller footprint. In contrast, applicants discovered that the cause of the problem was that each of the then current systems were only designed to efficiently house a single species of animal within ILAR guidelines.

Applicants' conception recognized that the solution to the problem was to provide a cage and rack system that was capable of efficiently housing more than one species of animal, while simultaneously meeting the ILAR requirements for housing each of those animal species. In other words, the solution to the problem was to invent a cage and rack system with respect to the overall efficiency of housing multiple species, instead of just the efficiency of housing one specific species. Accordingly, by simultaneously looking at the combined efficiency of housing multiple species of animals, applicants were able to invent a cage and rack system that solved the inventory and planning problems.

In *In re Wiseman*, 596 F.2d at 1022, 201 USPQ at 661, the claims at issue were directed to grooved carbon disc brakes wherein the grooves were provided to vent steam. The claims

were rejected as obvious over a reference showing carbon disc brakes without grooves in combination with a reference showing grooves in noncarbon disc brakes for a different purpose. The court affirmed the rejection, holding that even if applicants discovered the cause of a problem, the solution would have been obvious from the prior art which contained the same solution for a similar problem. MPEP § 2141.02.

In stark contrast to the facts in *Wiseman*, however, applicants' claimed invention, which resulted from discovering that a problem existed, as well as the source of that problem, claims a solution to a problem which is not recognized or addressed in the prior art. Moreover, in contrast to *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983), wherein the court found appellant's specification did not support the argument that he discovered the source of the problem, in the present application, applicants have provided evidence in the form of Declarations, to support the argument that applicants discovered a problem and the source of that problem.

Background

As background, and as described in the Declaration of Neil Campbell, one of the co-inventors of the claimed invention, the Institute for Laboratory Animal Research (ILAR) publishes requirements for cage size, each corresponding to a different animal size and/or species. These guidelines are meant to provide information so that different species of animals may be properly housed during laboratory experiments. For example, for mice that weigh more than 25 grams, a cage having a floor dimension of at least 15 square inches per mouse is required. Similarly, rats up to 400 grams in size require a cage floor dimension of at least

40 square inches per rat. For hamsters that weigh more than 100 grams, a cage floor dimension of at least 19 square inches per hamster is required.

Applicants are submitting, concurrently with this Amendment, the Declaration of Neil Campbell, a person of knowledge and experience in the relevant art. In his Declaration, Neil Campbell discusses the fact that he and his co-inventors discovered that a problem existed, and that the discovery of that problem was an inventive aspect of the invention claimed in the Application. Specifically, prior to the invention claimed in the Application, no one in the industry recognized the fact that each of the then current rack and cage systems were only designed to efficiently house a single species of animal within ILAR guidelines was a problem. Mr. Campbell and his co-inventors recognized that there was a problem and that the solution to the problem was to provide a cage and rack system that was capable of efficiently housing more than one species of animal, while simultaneously meeting the ILAR requirements for housing each of those animal species. Thus, the Campbell Declaration establishes the fact that in the prior art, there was no recognition of the problem of the inefficient use of lab space being caused by the size of animal cages, let alone any solution to that problem.

Discovering A Problem And The Source Thereof

Applicants discovered that the cause of the problem was not that a particular cage and rack system for a specific animal species should be made to have a smaller footprint. In contrast, applicants discovered the fact that, because each of the then current systems were only designed to efficiently house a single species of animal within ILAR guidelines, a problem existed.

Applicants recognized that the solution to the problem was to provide a cage and rack system that was capable of efficiently housing more than one species of animal, while simultaneously meeting the ILAR requirements for housing each of those animal species. In other words, the solution to the problem was to invent a cage and rack system with respect to the overall efficiency of housing multiple species, instead of just the efficiency of housing one specific species.

By simultaneously looking at the combined efficiency of housing multiple species of animals, applicants were able to design a cage and rack system that solved the inventory and planning problems discussed above.

An important feature of the claimed invention is that overall dimensions of the cage must be designed to simultaneously meet ILAR guidelines for more than one animal species.

Because there is a need by laboratories to move the rack and cage systems from room to room, there is also a need to design the rack and cage systems so that they may pass through a standard doorway (having a height of 6'8" and a width of 36"), while simultaneously meeting the ILAR guidelines.

The result of this inventive idea is embodied in a cage having a floor with a footprint of 80 square inches and a rack with a depth that is less than or equal to 36 inches, and that could house any of a plurality of rodent types (e.g., rats, mice, hamsters and guinea pigs) while simultaneously meeting ILAR guidelines for each of those species.

An embodiment of the invention, as claimed, for example, by claim 1 of the Application, is directed to a multipurpose cage level barrier rodent cage for housing multiple species of

rodents, including a plurality of mice or rats in a ventilated rack and cage system, the cage comprising a cage bottom having a plurality of integral side walls, a floor and an open top end, the floor having a length l and a width w wherein $80 \text{ square inches} \leq l \times w \leq 110 \text{ square inches}$.

Claim 2 recites a similar limitation, wherein $l \times w$ is equal to substantially 80 inches

An embodiment of the invention is also claimed, for example, by claim 3 of the Application, which recites a cage level barrier cage ventilated rack and cage system for housing a plurality of types of rodents including a plurality of mice or rats within a cage, the system comprising a double sided rack, the rack having a depth; at least one cage disposed in the rack, the cage having a cage bottom, the cage bottom having a plurality of integral side walls, a floor and an open top, and the length of the cage being less than substantially a 18 inches.

Similarly, claim 8 is directed to a cage level barrier cage ventilated rack and cage system for housing a plurality of types of rodents including a plurality of mice or rats within a cage, the system comprising: a double sided rack, the rack having a depth; and a cage disposed in the rack, the cage having a cage bottom, the cage bottom having a plurality of integral side walls, a floor and an open top, and the length of the cage being less than substantially a 18 inches; wherein the cage bottom has a length l and a width w , and wherein $80 \text{ square inches} \leq l \times w \leq 110 \text{ square inches}$.

Likewise, this embodiment of the invention is claimed by claim 9 of the Application, which is directed to a cage level barrier cage ventilated rack and cage system for housing a plurality of types of rodents including a plurality of mice or rats within a cage, the system comprising: a double sided rack, the rack having a depth; and a cage disposed in the rack, the

cage having a cage bottom, the cage bottom having a plurality of integral side walls, a floor and an open top, and the length of the cage being less than substantially a 18 inches; wherein the rack has a depth and the cage rests within said rack so that the length of the cage at least partially overlaps the depth of the rack and a portion of the cage extends beyond the rack, the portion having a length and the sum of the length of the portion and the depth of the rack is less than or equal to substantially 36 inches.

Accordingly, Applicants discovered that a problem existed, and the source of the problem, and it is apparent that the discovery of that problem and the source thereof was an inventive aspect of the invention claimed in the Application.

Objective Evidence Of Discovering A Problem And The Source Thereof

Applicants have also submitted, concurrently herewith, and in further support of applicants' contention of discovering a problem and the source thereof, the Declaration of Nick Guise. As stated in his Declaration, Mr. Guise has no financial interest in Lab Products, Inc., assignee of the present application (LPI). See Guise Declaration, paragraph 1. When in his previous position, the facilities where Mr. Guise was employed used equipment from a variety of suppliers, one of those suppliers being LPI. LPI equipment, however, was by no means favored or preferred at those facilities. Accordingly, prior to beginning his present position, Mr. Guise was not a loyal LPI customer of rodent cages and systems, but instead, a purchaser of equipment from various suppliers. See Guise Declaration, paragraph 5. Accordingly, Mr. Guise is an objective source of information regarding the present application.

As stated in his Declaration, upon seeing the One Cage™ system from LPI around the Fall of 1999, Mr. Guise realized that LPI had solved a problem not previously addressed by cage manufacturers. The problem being that, with floor space and storage being at a premium, prior to the One Cage™ system, suppliers had limited their improvements of cage systems to meet ILAR standards for each individual type of rodent size and/or species. Thus, manufacturers provide specialized rodent cage and rack systems, with each particular rodent cage and rack system being dimensioned and configured for a specific rodent type and/or size. See Guise Declaration, paragraph 7.

Accordingly, Mr. Guise has recognized that applicants inventively discovered a problem that had not previously been addressed in the prior art. Furthermore, Mr. Guise also recognizes that applicants discovered the cause of that problem, and the solution thereto.

According to Mr. Guise, LPI's One Cage™ System met Mr. Guise's Company's rodent caging system needs exceedingly well and enabled his company to accommodate different rodent species (i.e., sizes) with the benefit of reducing inventory of cage types as well as standardizing the size of each lab space due to the design and dimension of the One Cage™ System. Consequently, Mr. Guise's Company's efficiency and laboratory and storage space utilization was enhanced. See Guise Declaration, paragraph 10.

Since LPI's introduction of its One Cage™ System, Mr. Guise has not found any other cage level barrier rodent cage system that can accommodate a plurality of different rodent types, while meeting ILAR requirements for each rodent type, as can the One Cage™ System. See Guise Declaration, paragraph 12.

Accordingly, for the reasons stated above, and as stated in the Declaration of Nick Guise, applicants respectfully submit that applicants discovered that a problem existed, and the source of the problem, and it is apparent that the discovery of that problem and the source thereof was an inventive aspect of the invention claimed in the Application. Accordingly, applicants submit that claims 1, 2, 3, 8 and 9 are patentable over the cited prior art and respectfully request that the rejections to those claims under 35 U.S.C. § 103 be withdrawn.

Evidence Of Commercial Success

In addition to the arguments set forth above with respect to the inventive discovering of a problem and the solution thereof, applicants respectfully submit that certain products manufactured and sold by Lab Products, Inc (LPI), and covered by claims 1, 2, 3, 8 and 9 of the present application, achieved immediate commercial success. For this reason, and as set forth in detail below and as supported by the Declarations filed concurrently herewith, applicants further respectfully disagree with the characterizations made in the Office Action that applicants' claimed invention is obvious.

To overcome an obviousness rejection, an applicant may submit objective evidence of commercial success. See, e.g., *In re Ben Huang*, 100 F.3d 135, 139, 40 USPQ2d 1685 (Fed. Cir. 1996), citing *Graham v. John Deere Co.*, 338 U.S. at 17-18, 148 USPQ at 467 (1966); and MPEP §716.03 and §716.04. Applicants respectfully submit herewith the above-discussed Declarations of Nick Guise and Neil Campbell, as well as copies of the previously submitted Declarations of Betty Fatzie and Dietrich Crase, to support applicants' position that the present invention is not obvious over the Examiner's

proposed hypothetical combination of Sheaffer and AAPA, nor the Examiner's proposed hypothetical combination of Sheaffer and Coiro.

An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. The term "nexus" designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. See e.g., MPEP §716.03 and *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988). Applicants respectfully submit that such a factually and legally sufficient connection exists with regard to cage level barrier rodent cages and systems sold by LPI under the brand name One Cage™ System, and covered by at claims 1, 2, 3, 8 and 9 of the present application. Applicants further respectfully submit that such a nexus is clearly demonstrated by the Declarations of Nick Guise, Neil Campbell, Betty Fatzie and Dietrich Crase, submitted concurrently herewith.

With respect to claims 1, 2 and 8 of the present application, in Ms. Fatzie's Declaration, as noted in paragraph 9 thereof, when LPI began selling its One Cage™ System in 1999, LPI was then selling a variety of cage level barrier rodent cages and systems; each such cage and system being intended for use with a single, specific rodent type, and each such cage being sized to house a single specific rodent type or a plurality of that specific rodent type, and to meet ILAR standards. Thus, in 1999, a LPI customer could purchase from LPI (and ostensibly from other suppliers) a variety of different cage level barrier rodent cages and systems. Despite that fact,

sales of LPI's One Cage™ System for the first three years following its introduction (1999-2001) were \$9,430,000, accounting for 24% of LPI's gross sales for all its cage level barrier rodent cages and systems for that time period.

Applicants submit that one reason for the immediate commercial success of LPI's One Cage™ System is the fact that the novel and nonobvious dimensions of the cage level barrier rodent cage (as recited by claims 1, 2 and 8) eliminates the need for a laboratory to purchase and inventory a plurality of cage and rack sizes for distinct types (species) of rodents. That fact results in significant cost savings. See, e.g., Fatzie Declaration, paragraph 12. Applicants further respectfully submit that another reason for the immediate commercial success of LPI's One Cage™ System is that a cage level barrier rodent cage covered by claims 1, 2 and/or 8 (as is LPI's One Cage™ System) provides customers with the ability to standardize the size of their cage level barrier rodent cages and systems. See, e.g., Fatzie Declaration, paragraph 13. Finally, applicants respectfully submit that still another reason for the immediate commercial success of LPI's One Cage™ System is that a cage level barrier rodent cage covered by claim 1, 2 and/or 8 (as is LPI's One Cage™ System) eliminates the inefficiency that occurs during cleaning, sorting and delivering the various different size and shape cage level barrier rodent cages when transitioning from one study to the next, or in the ordinary course of cleaning the cages during a particular study. See, e.g., Fatzie Declaration, paragraph 14.

With regard to Mr. Crase's Declaration, applicants respectfully submit that paragraph 8 thereof clearly supports applicants claim of commercial success and further provides the necessary legal and factual nexus between the claimed invention and the commercial success. In

that paragraph, Mr. Crase states that the “benefits recognized by Advanced Medicine...are due to the...unique size and proportion [of LPI’s One Cage™ System], specifically, to the fact that the cage level barrier rodent cage of the One Cage™ System has a floor with a footprint with an area of 80 square inches.”

With regard to Mr. Guise's Declaration, applicants respectfully submit that paragraphs 7-14 thereof, clearly support applicants’ claim of commercial success and further provide the necessary legal and factual nexus between the claimed invention and the commercial success. In those paragraphs, Mr. Guise states that Mr. Guise’s employer, Wyeth Research, purchased “forty-three (43) One Cage™ rack and cage systems on October 13, 2000, and thirty-six (36) One Cage™ rack and cage systems on October 25, 2000.” See Guise Declaration, paragraph 8.

In his Declaration, Mr. Guise states that “LPI’s One Cage™ System met Wyeth Research’s rodent caging system needs exceedingly well and enabled Wyeth Research to accommodate different rodent species (i.e., sizes) with the benefit of reducing inventory of cage types,” and that “Wyeth has also been able to standardize the size of each lab space due to the design and dimension of the One Cage™ System.” See Guise Declaration, paragraph 9.

Mr. Guise also states in his Declaration that “[s]ince LPI’s introduction of its One Cage™ System, Wyeth Research has not found any other cage level barrier rodent cage system that can accommodate a plurality of different rodent types, while meeting ILAR requirements for each rodent type, as can the One Cage™ System.” See Guise Declaration, paragraph 12.

Mr. Guise, in his Declaration, further states that “Wyeth Research selected and continues to purchase LPI’s One Cage™ System” because “the cost savings [Wyeth realizes] by not having

to purchase and inventory different cage level barrier rodent cages and systems for [Wyeth's] different rodent type needs." See Guise Declaration, paragraph 13 and also that Wyeth has been able to "significantly improve and standardize [Wyeth's] use of laboratory and inventory space as a result of the standardized cage and rack footprint provided by the One Cage™ System," and that "the One Cage™ System is a significant improvement over other commercially available cage level barrier rodent cages and systems because it results in a more efficient use of valuable laboratory space and has simplified facilities planning and design." See Guise Declaration, paragraph 14.

It is important to note that Mr. Guise is not tied to LPI in any manner. Furthermore, it is also important to note that prior to the purchase of the above-mentioned One Cage™ System units by Wyeth, Mr. Guise was not a regular customer of LPI, and could not be characterized as a long term customer of, nor as being normally tied to, LPI.

Mr. Campbell is the President of LPI, and his Declaration complements the Declaration of Mr. Guise, describing specifically how the features attributed by Mr. Guise as leading to the commercial success of the One Cage™ System directly relate to the claims, and to the fact that the cage level barrier rodent cage of the One Cage™ System has a floor with a footprint with an area of 80 square inches.

Specifically, in his Declaration, Mr. Campbell states that by simultaneously looking at the combined efficiency of housing multiple species of animals, [Mr. Campbell and his co-inventors] were able to design a cage and rack system that solved the inventory and planning problems" discussed in the Declaration of Mr. Guise. See Campbell Declaration, paragraph 19.

Similarly, Mr. Campbell further states that he and his co-inventors “recognized that the overall dimensions of the cage must be designed to simultaneously meet ILAR guidelines for more than one animal species.” See Campbell Declaration, paragraph 20. Mr. Campbell and his co-inventors “recognized that there is a need of laboratories to move the rack and cage systems from room to room, and have a rack and cage system that can easily pass through a standard doorway (having a height of 6’8” and a width of 36”), while simultaneously meeting the ILAR guidelines.” See Campbell Declaration, paragraph 21.

Mr. Campbell further describes that the “result of this inventive idea is embodied in a cage having a floor with a footprint of 80 square inches and a rack with a depth that is less than or equal to 36 inches, and that could house any of a plurality of rodent types (e.g., rats, mice, hamsters and guinea pigs).” See Campbell Declaration, paragraph 22. Mr. Campbell states that these features are recited by claims 1, 2 and 8 of the present Application. See Campbell Declaration, paragraphs 23-25.

Accordingly, applicants respectfully submit that the Fatzie, Crase, Campbell and Guise Declarations, taken together, provide the necessary legal and factual nexus between the claimed invention (as recited by claims 1, 2 and 8) and the commercial success of LPI’s One Cage™ System which, as stated above, is covered by claims 1, 2 and 8 of the present application.

Evidence of nonobviousness including commercial success, such as that provided by applicants by way of the Fatzie, Crase, Campbell and Guise Declarations, must be commensurate in scope with the claims. See, e.g., MPEP §716.03 and *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971). In order to be commensurate in scope with the claims, the commercial

success must be due to claimed features, and not due to unclaimed features. See, e.g., MPEP §716.03 and *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229, 17 USPQ2d 1257, 1260 (D.D.C. 1990), *aff'd*, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992). Once again, applicants respectfully submit that the Fatzie, Crase, Campbell and Guise Declarations establish that the commercial success experienced by LPI with its One Cage™ System was due to the novel and unobvious dimensions of the cage level barrier rodent cage (as recited by claims 1, 2 and 8). See, e.g., Fatzie Declaration, paragraphs 3 and 9-14; Crase Declaration, paragraphs 6-8; Guise Declaration, paragraphs 9 and 12-14; and Campbell Declaration, paragraphs 19-21 and 23-25.

Applicants respectfully submit that the commercial success of LPI's One Cage™ System was due to the novel and unobvious dimensions of the cage level barrier rodent cage provided as part of that System; those dimensions being recited in claims 1, 2 and 8. Applicants further respectfully submit that the Declarations of Betty Fatzie, Dietrich Crase, Neil Campbell and Nick Guise support applicants' position, and provide sufficient legal and factual nexus between the commercial success and the invention recited by claims 1, 2 and 8. For those reasons, applicants respectfully submit that the rejection of claims 1, 2 and 8 under 35 U.S.C. §103 as unpatentable over Sheaffer in view of AAPA is no longer tenable, and applicants respectfully request withdrawal of that rejection and reconsideration of the patentability of claims 1, 2 and 8 in view of the remarks provided above and further in view of the Fatzie, Crase, Campbell and Guise Declarations filed herewith.

Applicants now turn to the rejections of claims 3 and 9 under 35 U.S.C. §103 as being unpatentable over Sheaffer in view of U.S. Patent No. 5,894,816 to Coiro, Sr. et. al. (Coiro). As set forth in more detail below, and as supported by the Declarations filed concurrently herewith, applicants respectfully disagree with the Office Action and, without amending those claims, respectfully traverse that rejection.

The Fatzie, Crase, Campbell and Guise Declarations again provide evidence of the commercial success of LPI's One Cage™ System, which is covered by claims 3 and 9. Applicants submit that the commercial success of LPI's One Cage™ System is again due to the novel and unobvious dimensions of the cage, as recited by claims 3 and 9. By providing a cage having a length that is substantially less than 18 inches, as recited by claim 3, or a rack and cage system having a depth that is less than or equal to substantially 36 inches, as recited by claim 9, LPI's One Cage™ System provides a cage level barrier ventilated rack and cage system for housing a plurality of types of rodents with a standardized footprint. For example, the 18 inch footprint defined by the length of the cage, and the 36 inch footprint defined by the cage and rack system enables LPI's One Cage™ System to fit through a standard commercial doorway. See, e.g., Fatzie Declaration, paragraph 4; and Campbell Declaration, paragraph 21. That simplifies facilities planning and design because a single doorway size will accommodate the cage level barrier ventilated rack and cage systems for a plurality of different rodent types (using LPI's One Cage™ System). See, e.g., Fatzie Declaration, paragraph 13; Crase Declaration, paragraph 11; and Campbell Declaration, paragraph 22. A standardized footprint also enables more efficient

use of laboratory space. See, e.g., Fatzie Declaration, paragraph 13; Crase Declaration, paragraph 11; Guise Declaration, paragraph 14; and Campbell Declaration, paragraph 18.

Accordingly, applicants respectfully submit that the novel features recited by claims 3 and 9 have directly contributed to the commercial success of LPI's One Cage™ System. In addition, applicants submit that the Declarations submitted herewith in support of applicants' position regarding the commercial success of LPI's One Cage™ System overcome the obviousness rejection of claims 3 and 9.

Lack Of Motivation To Combine References

With respect to the rejections to claims 3, 8 and 9, applicants also take this opportunity to address the deficiencies of the hypothetical Coiro--Sheaffer combination of prior art reference set forth in the Office Action. Specifically, the proposed hypothetical combination is inconsistent with the Federal Circuit's admonition that in evaluating obviousness it is not proper to use the applicants' disclosure as a template upon which the prior art is grafted. *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614(Fed. Cir. 1999). The justification stated in the Office Action does not constitute the "showing of the teaching or motivation to combine prior art references" required by the Court in *Dembiczak*. In that case the Federal Circuit states that "the showing must be clear and particular", and that "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'"

Specifically, with respect to claims 3, 8 and 9, the Office Action does not address why one skilled in the art would look to combine the cage of Coiro with the rack system of Sheaffer, as the two references disclose very different systems. As discussed above, prior art rack and cage systems, such as

that disclosed in Coiro and Sheaffer, do not recognize or address the problem having different cage systems for different animal species, or of providing the solutions described herein. Accordingly, because neither Coiro nor Sheaffer recognize or discuss the problems discussed above with rack and cage systems each being designed for a specific animal species and/or size, neither reference provides a motivation, either explicit or implicit, to combine the cage of Coiro with the rack of Sheaffer. Furthermore, because Sheaffer describes a cage having a specific mounting and coupling mechanism to position it within the rack (see, e.g., Sheaffer at FIG. 4), there is no indication in Coiro that the rack of Coiro would be the type that would even work within the cage of Sheaffer, providing further evidence of no disclosure of motivation to combine the references.

Moreover, with respect to claim 8 of the present application, not only do neither of the references provide any motivation for combining the references, but Coiro's specific disclosure of a preference of a 75 square inch cage area (see Coiro at col. 5, lines 63), as discussed in the Office Action, is actually in stark contrast to, and teaches away from, a cage wherein the cage bottom "has a length l and a width w , and wherein $80 \text{ square inches} \leq l \times w \leq 110 \text{ square inches}$ " as is claimed by claim 8 of the present application.

Accordingly, applicants respectfully traverse these rejections because there is no teaching or suggestion in the references to make the hypothetical combination proposed in the Office Action, and thus the combination is improper.

Conclusion

Accordingly, applicants respectfully submit that they have discovered that a problem existed and also discovered the source of that problem, and that those inventive discoveries

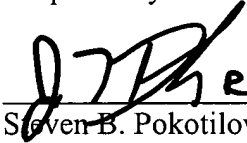
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resulted in the claimed invention of the present application. Furthermore, by Declarations submitted concurrently herewith, applicants have provided evidence in support of their claim of discovering the source of a problem. None of the cited prior art references contain a recognition of the problem discovered by applicants, let alone the same solution for a similar problem to the source of the problem discovered by applicants. Accordingly, applicants' claimed invention is patentable, at least because applicant's claimed invention is the result of applicants inventive discovering of a problem, and the inventive discovering of the source of that problem, as well as for the other reasons stated above.

Applicants thus believe that all claims pending in the present application (i.e., claims 1-3, 8 and 9) are in condition for allowance. Applicants respectfully request reconsideration of the present application in view of the amendments to the claims and remarks provided herein.

Any fees or charges required at this time and in connection with this Amendment and with the present application may be charged to Deposit Account No. 19-4709.

Respectfully submitted,

For  REG NO. 46,666
Steven B. Pokotilow
Registration No. 26,405
Attorney for Applicants
STROOCK & STROOCK & LAVAN LLP
180 Maiden Lane
New York, New York 10038-4982
(212) 806-5400